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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/709,233

Applicant(s)

LADOCSI ET AL.

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-21 are presented for examination. Applicant filed an amendment on 10/18/04 amending claims 11, 18, and 19 and adding new claims 20 and 21. After careful consideration of Applicant's arguments, the Examiner finds Applicant's arguments nonpersuasive and maintains the rejection of claims 1-19 based on 35 USC 101 and 35 USC 103. In addition, new grounds of rejection are established for newly added claims 20 and 21 as set forth in detail below.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 13, 14, and 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

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subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system, data processor) within the recited steps of the claimed method of predicting life expectancy. The recited steps constitute an idea on how to predict life expectancy of an individual.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for determining the life expectancy of an individual.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 11, 13, 14, and 16-18 are deemed to be directed to non statutory subject matter. The Examiner suggests adding language within the body of the claim limitations indicating that the method steps are carried out through the use of technology (i.e. processor, computer).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 6, 8, 11-13, 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kendrick , Pat. No. 5,031,161 in view of Minturn, Pat. No. 5,692,501.

As per claim 1, Kendrick discloses a life expectancy management system (i.e. microprocessor based)(see abstract) which comprises:  
a means for altering or adjusting said data based upon the occurrence of at least one event (i.e. resetting operation)(col. 5, line 54 – col. 6, line 65)  
a means for predicting life expectancy based upon said health profile data and said altered or adjusted data (see claims 1 and 5, col. 4, lines 1-22 and col. 5, line 54 – col. 6, line 65).

Kendrick does not explicitly disclose

a means which is capable of storing health profile data.

However, Minturn discloses a means which is capable of storing health profile data (i.e. optimal health/fitness database)(col. 12, lines 47-60 and col. 14, lines 37-58). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means which is capable of storing health profile data as disclosed by Minturn within Kendrick for the motivation of counseling participants in making positive improvements in their measured levels of optimum wellness, health and outlook (col. 10, lines 5-12).

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As per claim 2, Kendrick does not explicitly disclose the system according to claim 1 wherein the storage means is a machine readable storage medium.

However, Minturn discloses the system according to claim 1 wherein the storage means is a machine readable storage medium (i.e. software)(col. 13, lines 1-3). ). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the storage means is a machine readable storage medium as disclosed by Minturn within Kendrick for the motivation of counseling participants in making positive improvements in their measured levels of optimum wellness, health and outlook (col. 10, lines 5-12).

As per claim 3, Kendrick does not explicitly disclose the system according to claim 1 wherein said health profile data comprises at least one of the following: genetic data, birth data, lifestyle data, pediatric health data, and adulthood health data

However, Minturn discloses wherein said health profile data comprises at least one of the following: genetic data, birth data, lifestyle data, pediatric health data, and adulthood health data (i.e. personal medical, health and fitness histories)(col. 14, line 65 - col. 15, line 6). ). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said health profile data comprises at least one of the following: genetic data, birth data, lifestyle data, pediatric health data, and adulthood health data as disclosed by Minturn within Kendrick for the motivation of counseling participants in making positive improvements in their measured levels of optimum wellness, health and outlook (col. 10, lines 5-12).

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As per claim 5, Kendrick discloses the system according to claim 1 wherein said means for predicting life expectancy is a microprocessor comprising a prediction modeling logic (col. 6, lines 29-37)

As per claim 6, Kendrick discloses the system according to claim 5 wherein said prediction modeling logic provides a predetermined life expectancy which is reduced by deviations from expectations which are calculated from said health profile data and said altered or adjusted data (col. 4, lines 1-5 and col. 6, lines 29-40).

As per claim 8, Kendrick does not explicitly disclose the system according to claim 1 wherein said means for altering said data is a microprocessor and/or Internet service provider which is in communication with said storage means.

However, Minturn wherein said means for altering said data is a microprocessor and/or Internet service provider which is in communication with said storage means (Fig. 1 and col. 12, line 66 - col. 13, line 32). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said means for altering said data is a microprocessor and/or Internet service provider which is in communication with said storage means as disclosed by Minturn within Kendrick for the motivation of counseling the maximum number of participants in making positive improvements in their measured levels of optimum wellness, health and outlook (col. 10, lines 5-12).

As per claim 20, Kendrick does not explicitly disclose the method of claim 1 wherein the means for predicting life expectancy selects health profile data elements, prioritizes the selected data elements and weighs the prioritized data elements.

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However, Minturn discloses selecting ranking and weighing health data elements (see Fig. 7 and 8). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Minturn within Kendrick for the motivation stated for claim 1 above.

As per claims 11-13, 15, 16 and 18-19, the claims are substantially similar to claims 1-3, 5, 6, and 8 and are rejected on the same basis.

5. Claims 4, 7, 14, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kendrick and Minturn as applied to claims 1, 6, 11 and 16 above, and further in view of Summerell et al., Pat. No. 5,937,387 (hereinafter Summerell).

As per claim 4, Kendrick and Minturn do not explicitly disclose the system according to claim 1 wherein said event is selected from the group consisting of: chronic and routine health events, emergency health events, pregnancy data and medical advancements.

However, Summerell discloses said event is selected from the group consisting of: chronic and routine health events, emergency health events, pregnancy data and medical advancements (see Fig. 10). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said event is selected from the group consisting of: chronic and routine health events, emergency health events, pregnancy data and medical advancements as disclosed by Summerell within Kendrick



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and Minturn for the motivation of counseling individuals to adopt healthy lifestyles (col. 2, lines 57-65).

As per claim 7, Kendrick and Minturn do not explicitly disclose the system according to claim 6 further comprising a means for providing recommended goals and incentives based upon the life expectancy predicted and the predetermined life expectancy.

However, Summerell discloses a means for providing recommended goals and/or incentives based upon the predicted physiological age and the chronological age (col. 17, lines 7-27). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a means for providing recommended goals and/or incentives based upon predetermined and predicted wellness and life goals as disclosed by Summerell within the life expectancy system of Kendrick and Minter for the motivation of counseling individuals to adopt healthy lifestyles (col. 2, lines 57-65).

As to claims 14, 17, and 21, the claims are similar in scope to claims 4 and 7 and are rejected on the same basis.

6. Claims 9, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kendrick and Minturn as applied to claims 1 and 11 above, and further in view of Ballantyne et al., Pat. No. 5,867,821 (hereinafter Ballantyne).

As per claims 9, 10 and 17, Kendrick and Minturn do not explicitly disclose the system according to claim 1 further comprising a means for providing secure access only to said health profile data and said altered or adjusted data.

However, Ballantyne discloses a means for providing secure access only to said health profile data and said altered or adjusted data (i.e. personal ID number)(col. 7, line 66 - col. 8, line 34). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a means for providing secure access only to said health profile data and/or said altered or adjusted data as disclosed by Ballantyne within Kendrick and Minturn for the motivation of authenticating individuals requesting access to the health profile data (i.e. health record database)(col. 8, lines 1-5).

### ***Response to Arguments***

7. With respect to Applicant's arguments directed to the rejection of claims 11, 13, 14, and 16-18 based on 35 USC 101, Applicant argues that the claim has been amended to recite the claimed steps are part of a method implemented on a computer. The Examiner disagrees. The Applicant amended the preamble to independent claims 11 and 18. Language indicating that the method is to be performed by a computer in preamble only is insufficient to overcome the 35 USC 101 rejection for not falling within technological arts. Moreover, nowhere in the body of the claims is there an indication that any of the steps are carried out by the use of a computer or microprocessor. The Examiner suggested that the Applicant include such language in the body of the independent claims (see previous non final rejection mailed 1/29/2004). Therefore, the 35 USC 101 rejection of claims 11, 13, 14, and 16-18 is maintained.

8. With respect to claim 1, Applicant argues that the Kendrick and Minturn do not

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Explicitly disclose "a means for predicting life expectancy based upon said health profile data and said altered or adjusted data". Specifically Applicant argues that the means of this element is a microprocessor with disclosed characteristics and loaded with particular disclosed health profile data and that determines according to a program a life expectancy value (page 7, Applicant's Response, 10/18/04). The Examiner disagrees. The Kendrick reference discloses a digital timepiece for displaying the time remaining in a user's life (see abstract). The timepiece includes a microprocessor unit 50 (see abstract and Fig. 3) for determining the time remaining in a user's life (i.e. life expectancy). In addition, the microprocessor contains an algorithm that mimics actuarial data in Table I that automatically adjusts the projected life expectancy of the user (col. 4, lines 17-22). In addition, specific user health factors, as shown in Table II, that affect the user's life expectancy may be programmed and input into the processor (col. 6, lines 29-37). Therefore, Kendrick contains a microprocessor and automatically determines life expectancy values.

Applicant also argues that the Kendrick and Minturn do not disclose health profile data as described in the specification of the instant application. However, the Examiner notes that the specification does not explicitly define health profile data as suggested by Applicant. In fact, the specification uses exemplary language when describing types of health profile data and provides examples of various types of health profile data as envisioned by the Applicant (see specification, page 6). The specification does not explicitly define health profile data and therefore Applicant's argument is nonpersuasive.

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Applicant argues that the remaining independent claims (11, 18 and 19) are substantially similar to claim 1 and should be allowed for the same reasons as claim 1. However, the Examiner found Applicant's arguments to claim 1 to be nonresponsive and the same reasons apply to the remaining independent claims. Applicant also argued that the remaining dependent claims are allowable based on their dependency to the independent claims. The Examiner found Applicant's arguments to the independent claims to be nonpersuasive and finds Applicant's arguments directed to the remaining dependent claims to be non persuasive for the same reasons.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 872-9306 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read 'Alexander Kalinowski', with a stylized, cursive script.

Alexander Kalinowski

Primary Examiner

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1/3/05